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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,254	10/31/2003	Yoichi Hoshino	SHO-0026	9922

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EXAMINER	
HARPER, TRAMAR YONG	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,254	HOSHINO ET AL.	
	Examiner	Art Unit	
	Tramar Harper	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/22/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application Numbers 10/697,249, 10/697,237, 10/697,007, 10/697,441, 10/697,004, 10/697,259, 10/697,054, and 10/697,251. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the applications claim the same inventive concept.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The applicant has a duty to disclose any other related applications and to obviate any other double patenting issues must provide a patentably distinct line of demarcation between the applications.

Claim Rejections - 35 USC § 112

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "liquid crystal panel" in line 1. There is insufficient antecedent basis for this limitation in the claim, and this limitation is not positively recited in claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by the US Patent of Loose (6,517,433).

In terms of claim 1, Loose teaches the invention of a gaming machine that comprises of mechanical rotatable reels of symbols as a variable display means and a video display as a more front side display means (Fig. 2a). The video display provides

a synthesized plurality of images, such as graphics illustrating beneficial states, upon the variable display means (Abstract). Also, Fig. 6 illustrates how the video display outlines the predetermined image with higher priority among the plural images.

As for claim 3, Loose teaches that the player of the gaming device inputs a wager amount that is transmitted to the processor. The processor responds by executing a game code that randomly selects a predetermined outcome. The reels of symbols are thus rotated, stopped, and displayed based on the predetermined outcome (Specification – Paragraph 4, Fig. 6).

As for claim 5, Figures 8a-c illustrates the predetermined image as being of a non-transparent color.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 4, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loose (6,517,433) in view of Muir (PCT – Wo 3039699 A1).

In terms of claim 2, Loose teaches all of the above claimed elements, as stated above, and he further teaches the use different alternative video display types such as CRT, LCD, LED, or other type known in the art (Specification – Paragraph 6). Muir teaches the use of a liquid crystal multilayer structure in a more front side of a variable display or set of reels (Fig. 8). The structure comprises the use of a liquid crystal display followed by a transparent panel with illuminating means attached. Also, the panel attached to the variable display acts as a reflection means to guide light through the light transparent panel to the liquid crystal display (Specifications Paragraph - 66). Loose does not specifically state the use of a liquid crystal multilayer structure. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that a multilayer liquid crystal structure, such as the one taught by Muir, be implemented as an alternative video display means.

As for claim 4, Figures 8a, 8b, and 8c illustrate the transformation from a blank symbol to a bell in the symbol display area or light transmittable part (Loose).

As for claim 6, Loose and Muir teaches all of the claimed elements, as stated above, except for the liquid crystal panel set to a normally white mode. However, it is known in the art that normally white mode is an attribute of liquid crystal technology. It would have been obvious to one of ordinary skill in the art at the time of the invention to set the alternative liquid crystal panel to a normally white mode.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wells (US 2004/0029636) teaches a similar device that comprises of a slot machine with a superimposed display. Aida (US 2003/0130028) teaches a similar device with a normally white mode display. Nohara (4,998,170) teaches the concept of normally white mode. Ozaki (US 2001/0031658) and Gilmore (US 2003/0060271) both teach a similarly constructed gaming device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TH

03/28/06

JOHN M. HOTALING, II
PRIMARY EXAMINER